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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/668,315	09/22/2000	Jan Kall	781-377USW1	1322
32294	7590	08/04/2004	EXAMINER	
SQUIRE, SANDERS & DEMPSEY L.L.P. 14TH FLOOR 8000 TOWERS CRESCENT TYSONS CORNER, VA 22182			TRINH, SONNY	
			ART UNIT	PAPER NUMBER
			2685	

DATE MAILED: 08/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/668,315

Applicant(s)

KALL, JAN

Examiner

Sonny TRINH

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-12 is/are allowed.
- 6) ☒ Claim(s) 13, 14, 16 and 17 is/are rejected.
- 7) ☒ Claim(s) 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments with respect to claims 16-17 have been considered but are moot in view of the new ground(s) of rejection.

### *Allowable Subject Matter*

2. **Claims 1-12** were allowed by the previous Office action (paper number 9). The indicated allowability of **claims 13-15** is withdrawn in view of the newly discovered reference(s) to Naddell et al. (U.S. Patent Number 5,613,213 and to Pensak et al. (US 6,449,721). Rejections based on the newly cited reference(s) follow.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claim 13** is rejected under 35 U.S.C. 102(b) as being anticipated by Naddell et al. ("Naddell"; U.S. Patent Number 5,613,213).

Regarding **claim 13**, Naddell teaches an on-demand-service service center in a mobile communication system (figure 1, see description), comprising

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service means for offering at least one service-on-demand to a service area which comprises at least one mobile communication system cell (figure 1, columns 2-4), Naddell does not explicitly disclose the registration means for receiving and acknowledging the registration of a user of the service-on-demand nor the billing means responsive to the registration means for charging the user for the use of the service on demand, however, these means are inherent in Naddell's invention otherwise the services rendered are not accounted for (this is the reason for advertising the service-on-demand, e.g. to generate more revenue).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claim 14** is rejected under 35 U.S.C. 103(a) as being unpatentable over Naddell et al. ("Naddell"; U.S. Patent Number 5,613,213) in view of Pensak et al. ("Pensak"; U.S. Patent number 6,449,721).

Regarding **claim 14**, Naddell discloses the invention but does not disclose that the service means are arranged to encrypt the service-on-demand and the registration means are arranged to include a key in the registration acknowledgement.

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In an analogous art, Pensak discloses a method of encrypting information for remote access while maintaining access control. Pensak further teaches that the registered users are granted a key to decrypt the documents (column 2, specifically lines 52-65).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use, within the system of Naddell, the encryption method, as taught by Pensak, in order to allow only registered user to obtain the services and in the same time stopping unauthorized user from receiving the services. The motivation for doing so would be to make sure that the services provided are paid for by allowing only registered users to use the services.

5. **Claims 16-17** are rejected under 35 U.S.C. 103(a) as being unpatentable over Naddell et al. ("Naddell"; U.S. Patent Number 5,613,213).

Regarding **claim 16**, Naddell teaches a method for determining and displaying available services for a communication unit. With reference to figure 1, Naddell further teaches the base transceiver station (figure 1) for at least one cell, one of the channels being a cell specific broadcast channel for transmitting general information to mobile stations in the cell (control channel is inherent). Furthermore, Naddell teaches that the base transceiver station being arranged to transmit at least one service-on-demand over one of its channels available to all mobile stations located in the cell (columns 2-3). Naddell does not explicitly disclose that the channel being other than the cell specific broadcast channel

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general information. However, since Naddell's invention deals specifically with broadcasting available services to different communication units using an RF communication resource (columns 2-3), this communication resource channel is obviously different than the dedicated control channel in a regular base station transceiver.

Regarding **claim 17**, Naddell further teaches that the base transceiver station is arranged to transmit a notification of the services-on-demand available at the cell (columns 2-3).

***Allowable Subject Matter***

6. Claim 15 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding **claim 15**, the prior art provided numerous examples of service-on-demand announcement in a cellular network, but failed to disclose or fairly suggest the specific combination of structural and functional limitations set forth in claim 15, specifically, wherein the registration means are arranged to compute the number of the service on demand users, and the service means are arranged to transmit the service on demand if there is at least one user of the service on demand.

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## Conclusion

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

(703) 872-9306, (for formal communications intended for entry, for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, 6<sup>th</sup> Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sonny TRINH whose telephone number is 703-305-1961. The examiner can normally be reached on Monday-Thursday and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ed URBAN can be reached on 703-305-4385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

7/28/04

  
**SONNY TRINH**  
**PRIMARY EXAMINER**